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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/023,564	12/18/2001	Jyrki Hoisko	413-010737-US(PAR)	2681

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EXAMINER	
NGUYEN, DAVID Q	

ART UNIT	PAPER NUMBER
2681	5

DATE MAILED: 07/28/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/023,564	HOISKO ET AL.	
	Examiner	Art Unit	
	David Q Nguyen	2681	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *18 December 2001*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-31* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-23* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☒ Claim(s) *24-31* are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *4*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

1. This application contains claims directed to the following patentably distinct species of the claimed invention:

I) Claims 2-16 and 18-23 relate to the musical composition is attached to the message.

II) Claims 24-31 relate to an automatic state of mind recognizer.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claims 1 and 17 are generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the

examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

During a telephone conversation with ZIEGLER, GEZA on 07/16/04 a provisional election was made without traverse to prosecute the invention of group I, claims 2-16 and 28-23. Affirmation of this election must be made by applicant in replying to this Office action. Claims 24-31 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1 and 2 are rejected under 35 U.S.C. 102(b) as being anticipated by Goldberg et al. (US 6125175).

Regarding claims 1 and 2, Goldberg et al disclose a method for expressing an affective state of the caller and/or called party to the conversation partner in communication by telephone (see col. 2, lines 47-50), where the caller and called party send each other messages wherein during the communication, the recipient of a message hears a musical composition representing the affective state of the sender of the message (see col. 1, line 54 to col. 2, line 5; col. 3, lines 9-

11 and abstract); and wherein the message of caller and called party are speech messages (see col. 1, line 54 to col. 2, line 5; col. 3, lines 9-11 and abstract).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

3. Claims 3-19 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Goldberg et al. (US 6125175) in view of Cardina et al (US 6151500).

Regarding claim 3, the method of Goldberg et al does not disclose wherein the communication takes place in a system comprising equipment of an operator switching calls and in which system at least one phone is a cellular phone. However, Cardina et al discloses a system for sending message between caller and called party comprising equipment of an operator switching calls and in which system at least one phone is a cellular phone (see fig. 1 and abstract). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the above teaching of Cardina et al to the method of Goldberg et al. in order to provide background sounds in a telephone call between calling party and called party in wireless telecommunication.

Regarding claim 4, the method of Goldberg et al in view of Cardina et al also discloses wherein the phone of the caller is a cellular phone (see fig. 1 and abstract of Cardina et al); and

the musical composition is attached to the message sent by the caller (see col. 1, line 64 to col. 2, line 2 and col. 2, lines 44-54 of Goldberg et al). It is apparent that the method of Goldberg et al combined with the method of Cardina et al would suggest or disclose the musical composition is attached to the message sent by the caller in the caller's cellular phone.

Regarding claim 5, the method of Goldberg et al in view of Cardina et al discloses wherein the musical composition is transferred together with the message on the same audio channel from the cellular phone of the caller to the phone of the called party (see col. 1, line 64 to col. 2, line 2 and col. 2, lines 44-54 of Goldberg et al).

Regarding claim 6, the method of Goldberg et al in view of Cardina et al discloses wherein the phone of the called party is a cellular phone (see fig. 1 and abstract Cardina et al); and the musical composition is attached to the message sent by the caller (see col. 1, line 64 to col. 2, line 2 and col. 2, lines 44-54 of Goldberg et al). It is apparent that the method of Goldberg et al combined with the method of Cardina et al would suggest or disclose the musical composition is attached to the message sent by the caller in the cellular phone of the called party.

Regarding claims 7-9, the method of Goldberg et al discloses there is transferred from the caller to the called party an identifier on the basis of which the musical composition is selected; wherein the identifier specifies the name of the musical composition; wherein the identifier specifies the affective state of the caller (see col. 2, lines 45-54 of Goldberg et al); and Cardina et al discloses wherein the phone of the called party and caller are cellular phones (see fig. 1 and abstract Cardina et al). It is apparent that the method of Cardina et al combined with the method of Goldberg et al would disclose or suggest there is transferred from the cellular phone of the caller to the cellular phone of the called party an identifier on the basis of which the musical

composition is selected; wherein the identifier specifies the name of the musical composition; wherein the identifier specifies the affective state of the caller.

Regarding claim 10, the method of Goldberg et al in view of Cardina et al also discloses the musical composition is attached to the message sent by the caller in the equipment of the operator switching the call (see col. 1, line 64 to col. 2, line 2 and col. 2, lines 44-54 of Goldberg et al of Goldberg et al).

Regarding claims 11-13, the method of Goldberg et al in view of Cardina et al also discloses wherein there is transferred from the cellular phone of the caller to the operator an identifier on the basis of which the musical composition is selected; wherein the identifier specifies the name of the musical composition; wherein the identifier specifies the affective state of the caller (see col. 1, line 64 to col. 2, line 2 and col. 2, lines 44-54 of Goldberg et al of Goldberg et al).

Regarding claim 14, the method of Goldberg et al in view of Cardina et al also discloses wherein the phones of the caller and called party are cellular phones (see fig. 1 and abstract of Cardina et al); and from the caller to the called party there is sent a file which contains a musical composition stored in electric form (see col. 1, line 64 to col. 2, line 2 and col. 2, lines 44-54 of Goldberg et al of Goldberg et al). It is apparent that the method of Goldberg et al combined with the method of Cardina et al would suggest or disclose wherein the phones of the caller and called party are cellular phones and from the cellular phone of the caller to the cellular phone of the called party there is sent a file which contains a musical composition stored in electric form.

Regarding claim 15, the method of Goldberg et al in view of Cardina et al also discloses that wherein the musical composition is set to be played on the cellular phone of the called party (see abstract of Goldberg et al).

Regarding claim 16, the method of Goldberg et al in view of Cardina et al also discloses that wherein the musical composition is set to be played on a separate sound reproducing apparatus connected to the cellular phone of the called party (see abstract of Goldberg et al).

Regarding claim 17, Goldberg et al disclose a system for expressing an affective state of a caller and/or called party to the conversation partner in communication by telephone, where the caller and called party send each other messages (see col. 1, line 54 to col. 2, line 5; col. 2, lines 44-54 and col. 3, lines 9-11 and abstract); wherein the system further comprises a directory storing musical compositions representing various affective states and a menu for selecting musical compositions in the directory (col. 2, lines 44-54). Goldberg et al do not mention the system comprises at least one cellular phone and the equipment of an operator switching calls. However, Cardina et al discloses a system for sending message between caller and called party comprising equipment of an operator switching calls and in which system at least one phone is a cellular phone (see fig. 1 and abstract). It is apparent that the system of Cardina et al combined with the system of Goldberg et al would suggest or disclose the system comprises at least one cellular phone and the equipment of an operator switching calls.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the above teaching of Cardina et al to the method of Goldberg et al. in order to provide background sounds in a telephone call between calling party and called party in wireless telecommunication.

Regarding claim 18, the system of Goldberg et al in view of Cardina et al also discloses wherein the musical compositions are stored in the directory in electric form (see col. 2, lines 44-54 of Goldberg et al).

Regarding claim 19, the system of Goldberg et al in view of Cardina et al does not mention wherein the musical compositions are stored in the directory in the form of midi or mp3 files. Official notice taken that the musical compositions are stored in the directory in the form of midi or mp3 files is well known in the art. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the above teaching of the system of Goldberg et al in view of Cardina et al so that the caller/called party can listen to music in many different formats.

Regarding claim 22, the system of Goldberg et al in view of Cardina et al also discloses wherein the directory is in the equipment of the operator (see col. 2, lines 44-54 of Goldberg et al).

4. Claims 20-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Goldberg et al. (US 6125175) in view of Cardina et al (US 6151500) and further in view of Armanto et al (US 6094587).

Regarding claims 20-21, the system of Goldberg et al in view of Cardina et al does not mention wherein the directory is in the cellular phone of the caller; wherein the directory is in the cellular phone of the called party. However, Armanto et al disclose the directory is in the cellular phone (see abstract fig. 3). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the above teaching of Armanto et al to the

system of Goldberg et al. in view of Cardina et al in order to user can change musical composition as desired.

5. Claim 23 is rejected under 35 U.S.C. 103(a) as being unpatentable over Goldberg et al. (US 6125175) in view of Cardina et al (US 6151500) and further in view of Makelaet al (US 6501967)

Regarding claim 23, the system of Goldberg et al in view of Cardina et al does not mention wherein the menu is arranged to be at least in the cellular phone of the caller. However, Makelaet al disclose a menu is arranged to be at least in the cellular phone (see abstract). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the above teaching of Makelaet al to the system of Goldberg et al. in view of Cardina et al in order to user can change musical composition as desired.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David Q Nguyen whose telephone number is 703-605-4254. The examiner can normally be reached on 8:30AM-5:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Erika A Gary can be reached on 703-308-0123. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

DN

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